

REMARKS

Claims 23, 39-41, 44, 46, and 50-57 are pending in the application. All of the claims are subject to rejection for obviousness.

No new matter has been added.

I. Rejections under 35 U.S.C. § 103

Claims 23, 44, 46, 50, 51, and 54-57 were rejected for obviousness over Tanaka *et al.* in view of Ince *et al.* In the paragraph spanning pages 3-4, the Examiner states

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the claimed invention was made to identify a mammal with liver cancer wherein said liver cancer was associated with hyperactivity of IRS, and treat said mammal with dominant negative mutants of IRS-1.....The abstract of Ince *et al.* teaches that HAAH gene expression was associated with the activation of the IRS-1 signal transduction pathway (lines 12-16). Thus, it would be inherent in the identification of patients exhibiting hyperactivity of IRS-1 that said patients would comprise elevated levels of HAAH polypeptide.

Tanaka *et al.* do not describe HAAH, nor do they describe identifying a specific subset of individuals characterized by elevated HAAH levels compared to normal control levels. Ince *et al.* describes IRS-1 signal transduction and HAAH expression in human hepatocellular carcinoma cells. The Ince *et al.* abstract was published approximately one month before the filing of the patent application from which this divisional application claims priority. Therefore, Ince *et al.* is not prior art under 102(b). One's own work is not prior art under 102(a) even though it has been disclosed to the public in a manner, which otherwise would fall under that part of the statute. The Ince *et al.* reference is not prior art, because it is a description of the inventors' own work (See Declaration of the inventors under 1.132), and the other author was a postdoctoral fellow working under the direction and supervision of the inventors. Since Ince *et al.* is not prior art, and Tanaka *et al.* fail to describe or suggest HAAH, withdrawal of this rejection is respectfully requested.

Claims 39 and 40 were rejected for obviousness over Morris in view of Rogan and Tanaka as evidenced by Ince, and claims 39-41 were rejected for obviousness over Morris, Rogan, Tanaka, and the abstract of Ince in view of Ogawa. The only cited reference that describes HAAH is Ince *et al.* As is discussed above, the Ince *et al.* is not prior art. In the absence of the disclosure of Ince *et al.* with respect to HAAH and hepatocellular carcinoma, none of the other references combined teach all of the

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limitations of the amended claims, e.g., identification of a target patient group with elevated HAAH. Applicants therefore request withdrawal of this rejection.

CONCLUSION

Applicants submit that the application is in condition for allowance and such action is respectfully requested.

A petition for extension of time and a check in the amount of \$ 420.00 is enclosed to cover the petition fee for a two month extension of time pursuant to 37 C.F.R. § 1.17(a)(3). The Commissioner is hereby authorized to charge any fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No.21486-032 DIV3.

Should any questions or issues arise concerning the application, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,



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